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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/751,733	12/31/2003	John Vidor		3591
JOHN VIDOR 944 9th ST. #7 SANTA MONICA, CA 90403				
7590 05/14/2008				
EXAMINER				
NGUYEN, THUY-VI THI				
ART UNIT		PAPER NUMBER		
3689				
MAIL DATE		DELIVERY MODE		
05/14/2008		PAPER		

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

### Office Action Summary

**Application No.**

10/751,733

**Applicant(s)**

VIDOR, JOHN

**Examiner**

THUY-VI NGUYEN

**Art Unit**

3689

**Period for Reply** -- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 31 December 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-9 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-9 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 31 December 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-8508)
- 4) ☐ Interview Summary (PTO-413)
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_
- Paper No(s)/Mail Date \_\_\_\_\_

## DETAILED ACTION

### *Election/Restrictions*

1. Restriction to one of the following inventions is required under 35 U.S.C. 121:
  - I. Claims 1-7, 8- 9, drawn to method for allowing an individual to download the copyright content, creating a contract between two entities; classified in class 705 subclass 01.
  - II. Claims 10-12, drawn to a processing system for down loading the content classified in class 705, subclass 01.

The inventions are distinct, each from the other because of the following reasons:

2. Inventions in Groups I and II are unrelated. Inventions are unrelated if it can be shown that they are not disclosed as capable of use together and they have different designs, modes of operation, and effects (MPEP § 802.01 and § 806.06). In the instant case, the invention of group I is method for allowing an individual to download the copyright content, creating a contract between two entities while invention of group II is a processing system for down loading the content.

Because these inventions are independent or distinct for the reasons given above, because the search required for Group I, is not necessarily required for Groups II due to their different scope and subject, and vice versa, restriction for examination purposes as indicated is proper since it's a serious burden for the examiner to examine all of these amended claims.

3. Applicant is advised that the reply to this requirement to be complete must include an election of the invention, either group I or II, to be examined even though the requirement be traversed (37 CFR 1.143)
4. During a telephone conversation with John Vidor on 05/07/08 a provisional election was made without traverse to prosecute the invention of group 1, claims 1-9. Affirmation of this election must be made by applicant in replying to this Office action. Claims 10-12 are withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected invention.

***Claim Objections***

5. Claims 1-9 are objected to because of the following informalities: There are two claims number 6, two claims number 6, 7 and 9. Appropriate correction is required. It is assumed the independent claim of the second claim number 6 is the claim 7, the first claim 7 is claim 8, and the second claim 7 is claim 9. Furthermore, there are two steps (c) shown in claim 1. It is assumed the second step (c) is step d, and step (d) is step (e).

***Claim Rejections - 35 USC § 112***

6. Claims 1-9 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

**Claim 1**, step (d) recites "**a compensatory payment**", is this different with a compensatory payment that recites in the preamble? Claim 1, step (d) also recites a limitation "exonerated from a civil and criminal liability" it is unclear why the user is being exonerated when the user has never been accused of a crime. The Examiner suggests a different term to be used in order to better convey the claimed invention.

**Claim 3** recites "said concurrent service"; there is lack of antecedent and basis in the limitation of claim. Further more the Examiner is unsure that "a registration" limitation the same or different as a registration that recite in claim 1.

**Claim 4**, It is unclear that a copyright holder and a first copy right holder are the same entity or different. The second step where in recited "*said debt being owed to a first copyright holder, further including said first copyright holder of said file containing copyrighted content is not among said plurality of copyright holders*". There is lack of antecedent and basis for the term "**said plurality of copyright holders**".

**Claim 5** recites "said entity controlling an algorithm to obtain **said data** from said individual". There is lack of antecedent and basis for the term "said data" because it is not clear of what the data is referred to.

**Claim 7 (assumed to be claim 8)** is unclear to the examiner about the preamble and the body of claims is written. The preamble recites "...*said having been down loaded from a first storage medium not represented by said at least one copyright holder to a second storage medium not represented by said at least one copy right holder to a second storage medium not represented by said at least one copyright holder wherein said second storage medium belongs to said individual party...*". It is

assumed that a first and a second storage medium are not belongs to the copy right holders, and a second storage medium belongs to the individual who down load the digital content from a first storage medium. The preamble also recites "exonerated from a civil and criminal liability", it is unclear why the user is being exonerated when the user has never been accused of a crime. The Examiner suggests a different term to be used in order to better convey the claimed invention.

Furthermore, the Examiner is unsure about steps (a) and (b) where in recites "a first storage medium, and a second storage medium". Are they the same or different as a first and a second storage medium as mentioned in the preamble?

**Claim 7** (assumed to be claim 9) is unclear to the examiner because there are no step a, c, and d of claim 6 where the claim depend on. It's assumed the claim 7 (assumed to be claim 9) depends on the independent claim 7 (assumed to be claim 8). Furthermore, the claim recites "said user name", there is lack of antecedent and basis because the user name is not introduced in the independent claim 8.

### ***Claim Rejections - 35 USC § 102***

7. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

8. Claims 1-9 are rejected under 35 U.S.C. 102(e) as being anticipated by Galuten et al. US 7,209,892). Herein after is referred as Galuten.

**Regarding claim 1**, Galuten discloses a method for an entity to allow an individual to make a compensatory payment in return for said individual using a file-sharing service to download of one or more files containing copyrighted content, comprising:

a) creating a contract between an entity and a second payment receiver, said entity being identified as a first payment receiver [*...i.e. a contract between retailer/retailer websites (first payment receiver) and distributor/content owners (second payment receiver); retailer receives payment from the consumer for selling content on the Internet; and then retailer subscribe to the distributor service*; col. 6, lines 13-16; col. 7, lines 54-67; col. 9, lines 22-27 and figure 4;

b) obtaining a registration from an individual, said registration including at least one item of identifying information of said individual, said at least one item of identifying information being used by said entity to identify files containing copyrighted content which have been downloaded by said individual, said identifying information also being used to contact said individual [*...i.e. consumer is required to register and setup the accounts including personal information, credit card number; email, payment details*; col. 18, lines 57-61; col. 19, lines 50-67; col. 20, lines 1-5];

c), assigning a monetary amount to at least one category of file containing copyrighted content [*...i.e. the distributor set the prices of the content or list price of the content*; col. 7, lines 41-52; col. 13, lines 1-9];

d) charging said individual said monetary amount in return for said individual previously downloading one or more files containing copyrighted content [...i.e. *the payment will be processed after the content has been successfully delivered to the customer*; col. 4, lines 64-67; col. 5, lines 1-4; col. 27, lines 10-21; and figures 11-13];

e) receiving from said individual said monetary amount, said monetary amount constituting a compensatory payment for said at least one file containing copyrighted content, said compensatory payment exonerating said individual from liability related to said downloaded file [...*receiving the account information from the consumer and debit the consumer account; the consumer is authorized from copyright holder/distributor to download the content*; col. 24, lines 17-64; figures 11-13]. Therefore, Galuten inherently discloses the consumer/individual is exonerated or legally or not having trouble for downloading the content after the individual made a payment to copy right holder or distributor.

**Regarding claim 2**, Galuten discloses said file-sharing service and said first payment receiver are the same entity [...i.e. retail website is a first payment receiver and also is a file-sharing service; col. 4, lines 62-66 and figures 6- 7].

**Regarding claim 3**, Galuten discloses wherein said obtaining a registration from said individual occurs when said individual receives a service from a selection from the class consisting of said entity and an affiliate of said entity, said concurrent service being selected from the class consisting of telephone, subscription television, and Internet, said Internet including cable line, and DSL [...*Galeten discloses individual receives a service from retailers (entity) and distributors (affiliate of said entity) in*



*assisting with the management of sale and distribution of music over the Internet; abstract].*

**Regarding claim 4**, Galuten discloses wherein said entity incurs a debt to a second entity caused by first entity receiving said compensatory payment, said second entity being a copyright holder of said one or more files which have been downloaded by said individual, said debt being owed to a first copyright holder, further including said first copyright holder of said file containing copyrighted content is not among said plurality of copyright holders [...i.e. *Galuten discloses the retailer (first entity) subscribe to the distributor/content owner (second entity) who distributes and sales the content; col. 6, lines 9-21; figure 2 shows the content from plurality distributors/content owner.*].

**Regarding claim 5**, Galuten discloses further including said entity controlling an algorithm to obtain said data from said individual, said algorithm emanating from a memory at a first location, to scan a memory controlled by said individual, said memory of said individual being at a second location, said first and second locations being connected via the Internet, and wherein said scan results in a determination of the number of files containing copyrighted content having been downloaded onto said memory of said individual [...i.e. *allow the consumer to copy the acquired content from the consumer Player (memory at a first location) to another medium such as consumer electronic portable media (memory at a second location); the consumer will not allow to make more copies (determine number of files) than the rules allow; col. 25, lines 54-67; col. 26, lines 1-3].*

**Regarding claim 6**, Galuten discloses wherein the steps of claim 1 are performed in the order which they are listed [...figures 4, 6, 11, 13].

**Regarding claim 7**, Galuten discloses further including said individual providing a user name and password during said registration, so that said first compensatory payment is expedited by said individual providing said user name and password [...*consumer personal information*; col. 19, lines 64-67].

**Regarding claim 8**, Galuten discloses a method for a first compensatory payment receiver to allow an individual party to indirectly compensate at least one copyright holder of copyrighted content which exists within an electronic file, said electronic file having been downloaded from a first storage medium not represented by said at least one copyright holder to a second storage medium not represented by said at least one copyright holder wherein said second storage medium belongs to said individual party, further including said individual party receiving exoneration from a civil and criminal liability [...i.e. , ***a first compensatory payment receiver is a retailers or retail websites the individual or consumer directly download (to second storage website) and purchase music through retail website (first storage medium),; and these retailers of the website will subscribe the money to a copyright holder or distributor*** (col. 2, lines 43-55 ) (Note Galuten inherently discloses the consumer/individual is exonerated or legally or not having trouble for downloading the content after the individual made a payment to copy right holder or distributor )] comprised of:

(a) creating a contract with a group of copyright holders, said contract including at least one consensus, said at least one consensus including a first monetary amount which when charged of an individual party [...i.e. **a contract between retailer/retailer websites (first payment receiver) and distributor/content owners (second payment receiver); retailer receives payment from the consumer for selling content on the Internet; and then retailer subscribe to the distributor service; col. 6, lines 13-16; col. 7, lines 54-67; col. 9, lines 22-27 and figure 4; the contract including one consensus such as retailer's commission (col. 7, lines 54-67)**], constitutes permission by said group of copyright holders for said individual party to possess on a storage medium one or more files containing digitized content having a copyright held by at least one copyright holder being represented by said group of copyright holders wherein the acquiring of said one or more files containing digitized content having a copyright held by at least one copyright holder being represented by said group of copyright holders is resulting from downloading from a first memory storage not represented by said group of at least one copyright holders to a second memory storage not represented by said group of copyright holders, further including said second memory storage belonging to said individual party [...i.e. **allow the individual/customer to down load the contend from the contend owner/copyright holder/distributor through the retailer website; (col. 6, lines 9-21; figures1, 2 and 6); allow the consumer to copy the acquired content from the consumer Player (first storage medium) to another medium such as consumer electronic portable media (second storage medium); It is considered that first storage medium is**

***represented by the retailer (not copy right holder) and second storage is represented by individual/customer;*** col. 25, lines 54-67; col. 26, lines 1-3].

(b) registering said individual party to participate in a payment process which allows said individual party to indirectly compensate at least one copyright holder being represented by said group of copyright holders in return for said individual party acquiring one or more files containing digitized content having a copyright held by said at least one copyright holder being represented by said group of copyright holders wherein said acquiring one or more files containing digitized content having a copyright held by said at least one copyright holder being represented by said group of copyright holders is resulting from downloading from a first memory storage not represented by said at least one copyright holder being represented by said group of copyright holders to a second memory storage not represented by said at least one copyright holder being represented by said group of copyright holders further including said second memory storage belonging to said individual party [...***i.e. consumer is required to register and setup the accounts including personal information, credit card number; email, payment details;*** col. 18, lines 57-61; col. 19, lines 50-67; col. 20, lines 1-5); ***a first compensatory payment receiver is a retailers or retail websites the individual or consumer directly download (to second storage medium) and purchase music through retail website (first storage medium),; and these retailers of the website will subscribe the money to a copyright holder or distributor*** (col. 2, lines 43-55);

(c) acquiring data from said individual party, said data including an inventory of one or more files containing copyrighted content which has been downloaded from a

first storage medium not representing said at least one copyright holder being represented by said group of copyright holders to said second storage medium not representing said at least one copyright holder being represented by said group of copyright holders further including said second storage medium belonging to said individual party [...i.e. **the consumer will not allow to make more copies (determine number of files/inventory) than the rules allow**; col. 25, lines 54-67; col. 26, lines 1-3; **allow the consumer to copy the acquired content from the consumer Player (first storage medium) to another medium such as consumer electronic portable media (second storage medium); It is considered that first storage medium is represented by the retailer (not copy right holder) and second storage is represented by individual/customer**; col. 25, lines 54-67; col. 26, lines 1-3].

(d) receiving from said individual party said first compensatory payment via a selection from the class consisting of a credit card transaction, a bank account debit, a personal check, and an amount being added to a bill for a concurrent service provided to said individual party by said first compensatory payment receiver, said concurrent service being a selection from the class consisting of DSL, cable line, telephone, subscription television, software, and Internet, further including said receiving of said first compensatory amount exonerating said individual party from a civil and criminal liability [...i.e. **receiving account information from consumer; processing consumer's credit card account; the consumer is authorized to download the content**; col. 24, lines 17-64; figures 11-13]. Furthermore, it would have been obvious

to one of ordinary skill in the art to understand that the consumer is authorized or exonerated or allow for downloading the content after their payment is processed.

(e) incurring a monetary debt to a second compensatory payment receiver, said second compensatory payment receiver representing at least one copyright holder of one or more files which have been downloaded from a first memory storage not represented by said at least one copyright holder to a second memory storage not represented by said at least one copyright holder further including said second memory storage belonging to said individual party [...i.e. ***Galuten discloses the retailer (first entity) subscribe to the distributor/content owner (second entity) who distributes and sales the content; col. 6, lines 9-21; retailers get a commission from distributor for selling the content to customer; (col. 7, lines 55-67); and figure 2 shows the content from plurality distributors/content owner; allow the consumer to copy the acquired content from the consumer Player (first storage medium) to another medium such as consumer electronic portable media (second storage medium); It is considered that first storage medium is represented by the retailer (not copy right holder) and second storage is represented by individual/customer; (col. 25, lines 54-67; col. 26, lines 1-3)]***].

**Regarding claim 9**, Galuten discloses registering including said first compensatory payment receiver acquiring from said individual party and storing in a data analysis system at least one item of identifying information, said data analysis system being a component of a response processing system, further including said user name and password being used to expedite said individual repeating steps a), c), and d)

of this claim on a subsequent date to achieve the method [...*i.e. consumer is required to register and set up account of payment and tracking* (col. 18, lines 57-62); *information for account such as personal profile, payment details and these information are stored as a consumer's record* (col. 19, lines 50-67; col. 20, lines 1-15)].

### ***Conclusion***

9. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.
10. The US Patent to Yamamoto et al. discloses method and system for selling content; and US Patent Application Publication to Kurihara et al. disclose a content managing method that allow files of favorite contents to be stored in a predetermined user area; And to Vaidyanathan et al. disclose system and method for providing a digital file marketplace includes a plurality of digital files for access by consumers over a network.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Thuy-Vi Nguyen whose telephone number is 571-270-1614. The examiner can normally be reached on Monday through Thursday from 8:30 A.M to 6:00 P.M.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Janice Mooneyham can be reached on 571-272-6805. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Art Unit: 3689

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/T. N./

Examiner, Art Unit 3689

/Dennis Ruhl/

Primary Examiner, Art Unit 3689